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10/644,310	08/20/2003	Lance R. Peterson	3718611.01048	6023	
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K&L Gates LLP		MCCULLOCH JR, WILLIAM H			
P.O. Box 1135		ART UNIT		PAPER NUMBER	
CHICAGO, IL 60690		3714			
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

[chicago.patents@klgates.com](mailto:chicago.patents@klgates.com)

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/644,310	PETERSON ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	William H. McCulloch	3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 12 February 2010.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-93 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-93 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____.   | 6) <input type="checkbox"/> Other: _____ .                        |

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/12/2010 has been entered.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-93 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 6,203,430 to Walker et al. (hereinafter Walker '430) in view of U.S. 6,491,584 to Graham et al. (hereinafter Graham) and U.S. 2003/0220138 to Walker et al. (hereinafter Walker '138).

Regarding claims 1, 2, 28, 29, 41, 42, and 74, Walker '430 teaches a gaming device and method comprising: at least one display device (e.g., "conventional electronic display" in at least 6:21-34 and video display 336 in at least 5:42-50); at least one input device (e.g., starting controller 350; see 6:32-33); at least one processor (e.g., processor 302; see 5:63-65); and at least one memory device which stores a plurality of

instructions (e.g., data storage device 304; see at least 5:64-6:8), which when executed by the at least one processor, cause the at least one processor to operate with the at least one display device and the at least one input device to:

- Display a plurality of reels, the plurality of reels including a plurality of symbols (see Fig. 3B), said symbols including at least one first prize symbol associated with a first physical prize, at least one second prize symbol associated with a second different physical prize (e.g., Bells, Oranges, and Bars displayed as “tracked symbols” associated with respective physical prizes of 300, 250, and 200 credits, respectively; see Fig. 3B, 4A, and 8).
- Display a designated number of initial spins of the reels (see at least 3:33-51). In Walker '430, the player may designate the number of spins by controlling the wager of a number of credits and actuating the starting controller 350 (see at least 6:9-20 and 8:34-49).
- Display the initial spins of the reels after a wager by a player until none of the designated number of initial spins remain (e.g., the game provides the player a number of spins under the player's direction).
- Accumulate any first prize symbols which occur on the reels in each of said displayed initial spins and accumulate any second prize symbols which occur on the reels in each of said displayed initial spins (see at least 6:49-7:5).
- Cause the first physical prize to be awarded to the player if the accumulated number of first prize symbols reaches a designated number of first prize symbols necessary to be accumulated to win the associated first physical

prize (see at least 8:15-23), wherein the designated number of first prize symbols is greater than the number of first prize symbols which can possibly be accumulated in the displayed initial spins of the reels (e.g., in the case where an initial designated number of spins equals two, each spin providing a maximum of nine symbols, the player is unable to win a minimum prize requiring 75 orange symbols; see at least Fig. 8).

- Cause the second physical prize to be awarded to the player if the accumulated number of second prize symbols reaches a designated number of second prize symbols necessary to be accumulated to win the associated second physical prize (see at least 8:15-23), wherein the designated number of second prize symbols is greater than the number of second prize symbols which can possibly be accumulated in the displayed initial spins of the reels (e.g., in the case where an initial designated number of spins equals two, each spin providing a maximum of nine symbols, the player is unable to win a minimum prize requiring 50 bar symbols; see at least Fig. 8).

Walker '430 teaches the invention substantially as described above, but lacks in explicitly disclosing at least one re-trigger symbol or predetermined symbol combination (that causes re-triggering). In a related disclosure, Graham teaches a gaming machine with a re-trigger bonus, in which predetermined events, such as one or more triggering symbols appearing in an outcome of the game, initiate free or bonus games (see at least abstract, 1:29-2:26). It would have been obvious to modify the invention taught by Walker '430 to include the re-trigger features of Graham in order to retain and attract

potential gaming customers, as is favorably taught by Graham (see at least 1:12-26). It is noted that Graham explicitly teaches that the inventive bonus feature is “applicable in respect of any type of base games played on a gaming machine” and “particularly applicable in respect of spinning reel-type base games” (2:16-20). This teaching suggests further motivation to apply the concepts of Graham to the spinning reel type base game of Walker ‘430.

The combination of Walker ‘430 and Graham teaches the invention substantially as described above, but lacks in explicitly teaching wherein the initial designated number of spins is greater than one and that the numerical quantity of spins is displayed (as recited by the amended claims). Walker ‘138 teaches a flat rate play session, including “a method according to an embodiment of the present invention [that] allows payment to be received from a player in exchange for a predetermined number of outcomes at a player device (such as a gaming device, television, web terminal, etc.),” and the “predetermined number may be expressed as a number, or in terms of a combination of a minimum time (e.g., an hour) and minimum rate of play (no less than six plays per minute)” (par. 68). Furthermore, Walker ‘138 teaches that number of spins remaining is displayed on the gaming machine (see Fig. 10 and pars. 65-66).

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the teachings of Walker ‘430 and Graham such that more than one initial play of the game may be played by the player, as described in Walker ‘138, in order to advantageously allow the player to play multiple games while only making

funds available at the beginning of his play session. It is noted that the two Walker documents share multiple common inventors and a common assignee.

Claims 40, 56, 61 are directed toward similar subject matter to the above claims, and additionally include a primary and secondary game, wherein at least one triggering event associated with the primary game initiates the secondary game. Walker '430 teaches such at least by an initial game(s) ending and additional games beginning. Further, Graham teaches initiation of a number of bonus games upon a triggering event (see at least 1:29-2:26), which also meets the above limitation of primary (base) and secondary (bonus) games.

Claims 22, 34, 43, 48, 49, 67, 77 and 85 are directed toward similar subject matter to the above claims, except that an initial designated number of free spins of the reels are provided, with the opportunity to re-trigger at least one spin of the reels if the re-trigger symbol or a predetermined symbol combination occurs on the reels. Graham teaches such feature in at least 1:29-45 and 2:21-25. It is noted that Graham allows for triggering events to happen during a previously-triggered series of games, not solely for the base game. Furthermore, Walker '138 suggests extending a play session for free or for an additional payment (par. 194).

Regarding claims 3, 4, and 57, Walker '430 teaches at least one pay line associated with reels and further teaches that the processor accumulates any prize symbols that occur on any of the paylines in each spin of the reels (see at least Fig. 3B, 4:45-51, 6:21-33, and claim 17).

Regarding claims 5, 7, and 30, Walker '430 teaches that the accumulated number of prize symbols is reset when no spins remain or after a plurality of primary games (see at least 3:21-51 and 7:6-19).

Regarding claims 6 and 31, Walker '430 teaches that the initial designated number of spins is obtained in a primary game activated upon a wager by the player (see at least 6:9-15).

Regarding claim 8, Walker '430 teaches a prize symbol that includes an image that represents the physical prize (see at least Figs. 4A and 8, and descriptions thereof).

Regarding claims 9-10, Walker '430 teaches that the initial designated number of spins is predetermined at least because the player may designate the number of games he wishes to play. Walker '430 lacks in explicitly teaching that the designated number of initial spins is randomly determined. Regardless, such modification would have been an obvious matter of design choice, well within the capabilities of one of ordinary skill in the art at the time of invention.

Regarding claims 11-12, Walker '430 teaches that the designated number of prize symbols is predetermined or random (see at least Fig. 8 and descriptions thereof).

Regarding claims 13 and 14, Walker '430 teaches a plurality of different physical prizes, wherein the processor is operable to provide one of said physical prizes to the player when the accumulated number of prize symbols reaches the designated number of prize symbols necessary to win the physical prize; and further teaches that at least two of the physical prizes have different values (see at least Fig. 8 and descriptions thereof).

Regarding claims 15 and 16, Walker '430 teaches a probability of being selected by the processor associated with each of the physical prizes, wherein the processor is operable to select and provide one of the physical prizes to the player based on said probabilities (see at least 7:36-8:2).

Regarding claims 17-21 and 62, Walker '430 teaches a prize symbol display operable to indicate the number of accumulated prize symbols (Fig. 3b, element 360), further including a plurality of prize symbols indicators (Fig. 3b, element 360), further including an illumination device associated with the prize symbols indicators (Fig. 3A, video display 336), wherein the prize symbol display includes an integer which represents the accumulated number of prize symbols (Fig. 3b, element 360), and wherein the integer increments by at least one for each prize symbol which occurs on the reels (see at least 3:21-51 and 5:43-51).

Claims 23-26, 35-39, 44-47, 51-55, 58-60, 68-71, 78-82, and 87-91 are directed toward determining that 1) the initial number of spins, 2) prize symbols necessary to win a prize, 3) number of prize symbols, and 4) odds of obtaining a re-trigger event, is based at least in part on a wager made by the player. Each of these determinations is described at least by the citations of Walker '430 herein because each determination must be established when the player initiates a wagering session. Teachings of Walker '430 further dictate that the initiation is a result of the player making a wager. Therefore, Walker '430 teaches each of the above claims. With regard to claim 24, a first game of Walker '430 requires a first number of symbols to be accumulated. If during that first

game the player accumulates at least one symbol, the second (subsequent) game would require a different number of symbols to be accumulated in order to win the prize. With regard to claim 26, the combination of Walker '430 and Graham teaches that the symbols appearing on the reels are associated with a probability of winning, at least because both games are under the direction of a random number generator. Furthermore, Graham states that, "trigger frequency may decrease for at least some of the series of free games by changing the length or layout of the reel strips. This allows both the return to player percentage for different series of free games and/or the likelihood of getting a trigger condition to be adjusted as necessary or required" (3:59-64). Thus, if the player has paid for the current game/spin via a wager amount, he has a greater likelihood of achieving the free game symbol combination than if he was currently playing a free (no wager) game.

Regarding claims 27, 63, and 64, Walker '430 further teaches the processor is operable to enable the player to select the physical prize from a plurality of prizes (see at least 11:61-12:14).

Regarding claims 32, 33, 50, 75, 76, 86, Walker '430 describes a first physical prize that is of a higher value than the second physical prize, and further describes a higher probability of obtaining the second physical prize than the first physical prize (see at least Fig. 8).

Regarding claims 65-66, Walker '430 teaches awarding the physical prize to the player includes generating a prize code and further includes placing the prize code on at

least one of: a receipt, a ticket, a printing medium and a recording medium (see at least 9:6-13).

Regarding claims 72, 73, 83, 84, 92, and 93, Walker '430 teaches that the above described system and method are controller through a data network (see at least 5:1-25 and 8:24-32). The Internet is simply a group of networks in communication with one another. Therefore, Walker '430 suggests controlling the method and system over the Internet. Additionally, Walker '138 explicitly teaches both computer networks and the Internet (see par. 27).

***Response to Arguments***

4. Applicant's arguments filed 2/12/2010 have been fully considered but they are not persuasive.

Applicant appears to have cited an incomplete portion of the MPEP on page 25 of the Remarks. For Applicant's convenience, the relevant portion of MPEP 707.07(d) is reproduced herein: "The examiner should, as a part of the first Office action on the merits, identify any claims which he or she judges, as presently recited, to be allowable and/or should suggest any way in which he or she considers that rejected claims may be amended to make them allowable. If the examiner does not do this, then by implication it will be understood by the applicant or his or her attorney or agent that in the examiner's opinion, as presently advised, there appears to be no allowable claim nor anything patentable in the subject matter to which the claims are directed" (emphasis added).

On page 28 of the Remarks section, Applicant avers that the Examiner does not explain why one of ordinary skill in the art would be motivated to combine Walker '430 with Graham in the manner suggested by the grounds of rejection. The Examiner respectfully disagrees.

Graham explicitly teaches that features of the disclosure are useful for retaining and attracting potential gaming customers (see at least 1:12-26). This information is enough, in and of itself, to motivate one of ordinary skill in the art to modify features of existing slot devices to include beneficial features of Graham. In addition, it was noted above that Graham teaches the inventive bonus feature is "applicable in respect of any type of base games played on a gaming machine" and "particularly applicable in respect of spinning reel-type base games" (2:16-20). This teaching suggests further motivation to apply the concepts of Graham to the spinning reel type base game of Walker '430. Applicant's contention that the motivations given are "general" and not specific does not appear to be based upon any substantive reasoning at all.

Furthermore, one of ordinary skill in the art is presumed to have skills apart from what the prior art references expressly disclose. *In re Sovish*, 769 F.2d 738, 743 (Fed. Cir. 1985). A person of ordinary skill is also a person of ordinary creativity, not an automaton. *KSR*, 127 S.Ct. at 1742. Furthermore, the *KSR* Court recognized that "[w]hen there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill in the art has good reason to pursue the known options within his or her technical grasp." *KSR*, 127 S.Ct. at 1732.

Additionally, in *KSR*, the Supreme Court explained that a "rigid" teaching, suggestion, motivation ("TSM") test "is incompatible with our precedents." *KSR*, 127 S.Ct. at 1741. A rigid requirement of relying on only what is written in a prior art reference would, as the Supreme Court noted, unduly confine the use of the knowledge and creativity within the ordinary grasp of an ordinarily skilled artisan, *Id.* at 1742.

Arguments related to the Walker '127 reference are now moot in view of the new grounds of rejection. However, to the extent that flat rate play teachings are included in the new Walker '138 reference, Applicant's arguments are unpersuasive. For instance, Pages 29-32 of the Remarks section state that combining Walker '430 with a flat rate play system would allegedly destroy the intended functionality of Walker '430. Specifically, Applicant alleges that "if Walker '430 were modified to provide the player a flat rate play session having a designated time interval or a designated number of handle pulls...the gaming device resulting from [the combination] would appear to end the player's flat rate play session after the designated time interval or the designated number of handle pulls" (p. 32). The implication is that the combined invention would cause symbols to expire at the end of the plurality of handle pulls defining the play session. The Examiner notes that there is nothing explicit in the references to require such a scenario. One of ordinary skill would be more inclined to let the symbols expire after a number of plays of the game, which is taught by Walker '430, regardless of the length of the flat rate play session. Of course, the expiration of symbols may vary in Walker '430, so a symbol might expire before or after the conclusion of a flat rate play session.

Contrary to Applicant's assertion on pages 32-33, Walker '430's teaching of a separate wager for each play of the game does not "teach away" from flat rate play. The fact that the references are different does not result in 'teaching against', particularly because flat rate play can be seen as an improvement upon the traditional format of play where players wager on each spin/game. The differences are clearly laid out in the references and one of ordinary skill in the art would have easily understood them.

On pages 34-35, Applicant contends that because Walker '430 allows symbols to be accumulated in each spin it lacks a teaching of causing a designated number of prize symbols necessary to be accumulated to win a prize to be greater than a number of prize symbols which can possibly be accumulated in the displayed initial spins of the reels. The fact that Walker '430 allows symbols to be accumulated in each spin has nothing to do with the claimed feature that a designated number of prize symbols necessary to be accumulated to win a prize is greater than a number of prize symbols which can possibly be accumulated in the displayed initial spins of the reels. Therefore, Applicant has failed to present a logical reason as to why the teachings of Walker '430 are different from that of the claimed invention. A similarly deficient argument appears on pages 36-37.

Finally, Applicant argues on page 38 that the Walker '430 does not show determining a quantity of prize symbols necessary to win based upon a player's wager. Applicant states that for two different wagers made by the player, Walker '430 does not determine two different quantities of prize symbols necessary to be accumulated to win

a physical prize. The Examiner notes that there is nothing in the claimed invention that would require different quantities of symbols based on two different wagers. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In view of the above explanations, the claimed invention is unpatentable over the cited prior art.

***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and is listed on the attached Notice of References Cited.
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. McCulloch whose telephone number is (571) 272-2818. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/W. H. M./  
Examiner, Art Unit 3714  
3/15/2010

/Scott Jones/  
Primary Examiner, Art Unit 3714